

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In Re Application of:

Isaac Lagnado

Serial No.: 10/829,067

Filed: April 21, 2004

For: System And Method For Accessing A Wireless Network

Confirmation Number: 6812

Group Art Unit: 2617

Examiner: Brandon J. Miller

Docket No.: 200313247-1

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF**

Mailstop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In regard to the outstanding Notice of Non-Compliant Appeal Brief of May 11, 2009, Applicants submit the following remarks.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. §1.136(a), and any fees required therefor (including fees for net addition of claims) are hereby authorized to be charged to Hewlett-Packard Development Company, L.P. Deposit Account No. 08-2025.

## **REMARKS**

In the outstanding Notice of Non-Compliant Appeal Brief of May 11, 2009, it is alleged that Applicants' Appeal Brief filed on April 2, 2009 is defective for not addressing the U.S.C. §112 rejection in the appeal brief. In this regard, Applicants submit herewith an Amended Appeal Brief with a revised Grounds of Rejection to be Reviewed on Appeal and Arguments sections.

### **VI. Grounds of Rejection to be Reviewed on Appeal**

The following grounds of rejections are to be reviewed on appeal:

Claims 1 – 3, 5 – 11, 15, 26 – 27, 29 – 34, 36 – 37, 39 – 40, 42 – 48, 51 – 52, and 54 – 60 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*").

Claims 12 – 14, 35, 41, and 49 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*") and U.S. Patent Publication Number 2004/0003285 ("*Whelan*").

Claims 16, 18 – 21, 23, 25, and 50 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Number 7,076,256 ("*Orler*") and U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*").

Claim 24 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Number 7,076,256 ("*Orler*"), U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*"), and U.S. Patent Publication Number 2004/0003285 ("*Whelan*").

Claim 45 stands rejected under 35 U.S.C. §103 as allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*") and U.S. Patent Publication Number 2004/0153676 ("*Krantz*").

Claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

## **VII. Arguments**

Appellant respectfully submits that claims 1 – 3, 5 – 16, 18 – 21, 23 – 27, 29 – 37, 39 – 52, and 54 – 60 are patentable under 35 U.S.C. §103. Appellant respectfully requests that the Board of Patent Appeals overturn the final rejection of those claims at least for the reasons discussed below.

### **A. The Cited References**

#### **1. The *Sundar* Reference**

*Sundar* discloses "internetworking a mobile station to operate in a WWAN environment and in a WLAN environment" (Abstract).

#### **2. The *Nurminen* Reference**

*Nurminen* discloses a "wireless communications device controls its operational characteristics by receiving operational information across a short-range wireless network, and setting an operational characteristic of the device based on the received operational information" (Abstract).

**3. The Whelan Reference**

*Whelan* discloses a “monitor [that] checks the reported devices against a list of authorized network devices. If the reported wireless device is not an authorized device, the monitor determines if the reported device is connected to the network” (Abstract).

**4. The Orler Reference**

*Orler* discloses a “cellular telephone for use with a cellular telephone network includes a GPS receiver section” (Abstract).

**5. The Krantz Reference**

*Krantz* discloses “managing power consumption in a portable computing device having a network interface module is presented” (Abstract).

**B. Rejections Under 35 U.S.C. §103**

**1. Claims 1 – 3, 5 – 11, 15, 26 – 27, 29 – 34, 36 – 37, 39 – 40, 42 – 48, 51 – 52, and 54 – 60 are Allowable over *Sundar* in view of *Nurminen***

**a. Claim 1 is Allowable over *Sundar* in view of *Nurminen***

Claim 1 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 1. More specifically, claim 1 recites:

A method for accessing a wireless network, comprising:

detecting at least one wireless network within which a wireless device is located while the wireless device is in a transmit off mode; and

determining whether the at least one wireless network is on a list of requested wireless networks;

determining whether the at least one wireless network is on the list of requested wireless networks; and

***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 1 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “method for accessing a wireless network, comprising... ***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 1. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off***

**mode to a transmit on mode**” as recited in claim 1. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “**in response to a determination that the at least one wireless network is on the list of requested wireless networks**” as recited in claim 1. For at least these reasons, claim 1 is allowable.

**b. Claim 26 is Allowable over Sundar in view of Nurminen**

Claim 26 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 26. More specifically, claim 26 recites:

A system for accessing a wireless network,  
comprising:  
a wireless device; and  
application logic operatively associated with the  
wireless device and adapted to:  
switch the wireless device to a transmit off  
mode;  
detect at least one wireless network within  
which the wireless device is located while in the transmit  
off mode;  
determine whether the at least one wireless  
network is on a predetermined list of requested wireless  
networks; and  
***in response to a determination that the at  
least one wireless network is on the list of requested  
wireless networks, switching the wireless device from  
the transmit off mode to a transmit on mode.***

**(Emphasis added).**

Appellant respectfully submits that claim 26 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “system for accessing a wireless network, comprising... ***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 26. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 26. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “***in response to a determination that the at least one wireless***

***network is on the list of requested wireless networks***” as recited in claim 26. For at least these reasons, claim 26 is allowable.

c. **Claim 37 is Allowable over Sundar in view of Nurminen**

Claim 37 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 37. More specifically, claim 37 recites:

A system for accessing a wireless network,  
comprising:

means for switching a wireless device to a transmit  
off mode;

means for detecting at least one wireless network  
within which the wireless device is located while in the  
transmit off mode;

means for determining whether the at least one  
wireless network is on a predetermined list of requested  
wireless networks; and

***means for, in response to a determination that  
the at least one wireless network is on the list of  
requested wireless networks, switching the wireless  
device from the transmit off mode to a transmit on  
mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 37 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “system for accessing a wireless network, comprising... ***means for, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 37. First, the Final Office Action admits that *Sundar* does not specifically teach a



transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “**means for, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode**” as recited in claim 37. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “**in response to a determination that the at least one wireless network is on the list of requested wireless networks**” as recited in claim 37. For at least these reasons, claim 37 is allowable.

d. **Claim 42 is Allowable over *Sundar* in view of *Nurminen***

Claim 42 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully

traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 42. More specifically, claim 42 recites:

A system for accessing a wireless network,  
comprising:

a wireless device; and

application logic operatively associated with the wireless device, the application logic adapted to selectively switch the wireless device between a transmit on mode and a transmit off mode based on an identification of at least one wireless network, the application further configured to determine whether the at least one wireless network is on a list of requested wireless networks, ***the application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to the transmit on mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 42 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “system for accessing a wireless network, comprising... ***application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to the transmit on mode***” as recited in claim 42. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As

illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “**application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to the transmit on mode**” as recited in claim 42. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “**in response to a determination that the at least one wireless network is on the list of requested wireless networks**” as recited in claim 42. For at least these reasons, claim 42 is allowable.

**e. Claim 52 is Allowable over Sundar in view of Nurminen**

Claim 52 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 52. More specifically, claim 52 recites:

A method for accessing a wireless network, comprising:

automatically detecting at least one wireless network within which a wireless device is located while the wireless device is on and in a transmit off mode;

determining whether the at least one wireless network is on the list of requested wireless networks; and

***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 52 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “method for accessing a wireless network, comprising... ***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 52. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “***in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 52. Third, *Nurminen* discloses a

"[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)" (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an "inferred context." There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode "***in response to a determination that the at least one wireless network is on the list of requested wireless networks***" as recited in claim 52. For at least these reasons, claim 52 is allowable.

f. **Claim 57 is Allowable over *Sundar* in view of *Nurminen***

Claim 57 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*"). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 57. More specifically, claim 57 recites:

A system for accessing a wireless network, comprising:

a wireless device; and

application logic operatively associated with the wireless device and adapted to automatically detect at least one wireless network within which the wireless device is located while the wireless device is on and in a transmit off mode, the application logic further configured to determine whether the at least one wireless network is on the list of requested wireless networks, ***the application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 57 is allowable over the cited art for at least the reason that neither *Sundar* nor *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “system for accessing a wireless network, comprising... ***application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 57. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “***application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 57. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “***in response to a determination that***

***the at least one wireless network is on the list of requested wireless networks***” as recited in claim 57. For at least these reasons, claim 57 is allowable.

**g. Claims 2 – 3, 5 – 11, 15, 27, 29 – 34, 36, 39 – 40, 44 – 48, 51, 54 – 56, and 58 – 60 are Allowable over *Sundar* in view of *Nurminen***

Claims 2 – 3, 5 – 11, 15, 27, 29 – 34, 36, 39 – 40, 44 – 48, 51, 54 – 56, and 58 – 60 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* fails to disclose, teach, or suggest all of the elements of claims 2 – 3, 5 – 11, 15, 27, 29 – 34, 36, 39 – 40, 44 – 48, 51, 54 – 56, and 58 – 60. More specifically, dependent claims 2 – 3, 5 – 11, and 15 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 1. Dependent claims 27, 29 – 34, and 36 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 26. Dependent claims 39 – 40 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 37. Dependent claims 44 – 48 and 51 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 42. Dependent claims 54 – 56 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 52. Dependent claims 58 – 60 are believed to be allowable for at least the reason that they depend from and include the elements of allowable independent claim 57. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**2. Claims 12 – 14, 35, 41, and 49 are Allowable over *Sundar* in view of *Nurminen* and *Whelan***

Claims 12 – 14, 35, 41, and 49 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*") and U.S. Patent Publication Number 2004/0003285 ("*Whelan*"). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen* and *Whelan* fails to disclose, teach, or suggest all of the elements of claims 12 – 14, 35, 41, and 49. More specifically, dependent claims 12 – 14 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 11. Dependent claim 35 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 26. Dependent claim 41 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 37. Dependent claim 49 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 42. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**3. Claims 16, 18 – 21, 23, 25, and 50 are Allowable over *Sundar* in view of *Orler* and *Nurminen***

**a. Claim 16 is Allowable over *Sundar* in view of *Orler* and *Nurminen***

Claim 16 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Publication Number 2003/0134650 ("*Orler*") and U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*"). Appellant respectfully traverses this rejection for at



least the reason that *Sundar* in view of *Orler* and *Nurminen* fails to disclose, teach, or suggest all of the elements of claim 16. More specifically, claim 16 recites:

A system for accessing a wireless network,  
comprising:

a wireless device; and

application logic operatively associated with the wireless device and adapted to automatically detect at least one wireless network within which the wireless device is located while the wireless device is on and in a transmit off mode, the application logic further configured to determine whether the at least one wireless network is on the list of requested wireless networks, ***the application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode.***

***(Emphasis added).***

Appellant respectfully submits that claim 16 is allowable over the cited art for at least the reason that *Sundar*, *Orler*, and *Nurminen*, taken alone or in combination, discloses, teaches, or suggests a “system for accessing a wireless network, comprising... ***application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode***” as recited in claim 16. First, the Final Office Action admits that *Sundar* does not specifically teach a transmit off mode; and in response to a determination that the at least one wireless network is on the list of requested wireless networks, switching the wireless device from the transmit off mode to a transmit on mode” (OA page 3, line 19). Second, *Sundar* discloses “[a]s part of the beacon frame or the probe response, the AP sends a SSID... that identifies the AP 204. The mobile station 310 compares this SSID with a list of SSIDs... and if there is a match, infers that the WLAN 200 is a valid network for it to gain access” (page 4, paragraph [0058]). As illustrated in this passage, *Sundar* discloses that a comparison with a list is simply

performed to determine that there is a valid network. There is no consequence of a positive result to this comparison. Consequently, there is no suggestion of “**application logic further configured to, in response to a determination that the at least one wireless network is on the list of requested wireless networks, switch the wireless device from the transmit off mode to a transmit on mode**” as recited in claim 16. Third, *Nurminen* discloses a “[p]ower management configuration [that] may be changed for the device based on its inferred context... This may include, for example, turn on or off its transmitter(s)” (page 7, paragraph [0109]). As illustrated in this passage, *Nurminen* appears to disclose that power management may be changed based on an “inferred context.” There is absolutely no suggestion that a wireless device is switched from the transmit off mode to a transmit on mode “**in response to a determination that the at least one wireless network is on the list of requested wireless networks**” as recited in claim 16.

Additionally, *Orler* fails to overcome the deficiencies of *Sundar* and *Nurminen*. More specifically, *Orler* discloses a “handset 104 [that] automatically registers with the cellular telephone network 111 when it is powered on... After registration, the handset 104 then turns off its transmitter, although it continues to monitor the selected control channel 120 for incoming calls” (column 9, line 6 – 27). As illustrated in this passage, *Orler* discloses that a cellular telephone can turn off and then monitor for incoming telephone calls. This however, is different than claim 16. First, *Orler* fails to disclose any scenario for turning on the cellular telephone, except through user interaction. Second, even if, for sake of argument, *Orler* suggests turning on the cellular telephone, this suggestion would be limited to scenarios that occur in response to detection of an incoming telephone call and for the purpose of answering the telephone call. For at least these reasons, claim 16 is allowable.

**b. Claims 18 – 21, 23, 25, and 50 are Allowable over Sundar in view of Orlor and Nurminen**

Claims 18 – 21, 23, 25, and 50 stand rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Publication Number 2003/0134650 (“*Orlor*”) and U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Orlor* and *Nurminen* fails to disclose, teach, or suggest all of the elements of claims 18 – 21, 23, 25, and 50. More specifically, dependent claims 18 – 21, 23, and 25 are believed to be allowable for at least the reason that these claims depend from and include the elements of allowable independent claim 16. Dependent claim 50 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 42. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**4. Claim 24 is Allowable over Sundar in view of Orlor, Nurminen, and Whelan**

Claim 24 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 (“*Sundar*”) in view of U.S. Patent Publication Number 2003/0134650 (“*Orlor*”), U.S. Patent Application Publication Number 2005/0136837 (“*Nurminen*”), and U.S. Patent Publication Number 2004/0003285 (“*Whelan*”). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Orlor*, *Nurminen*, and *Whelan* fails to disclose, teach, or suggest all of the elements of claim 24. More specifically, dependent claim 24 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 16. *In re Fine, Minnesota Mining and Mfg.Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

**5. Claim 45 is Allowable over *Sundar* in view of *Nurminen*, and *Krantz***

Claim 24 stands rejected under 35 U.S.C. §103 for allegedly being unpatentable over U.S. Patent Publication Number 2003/0134650 ("*Sundar*") in view of U.S. Patent Application Publication Number 2005/0136837 ("*Nurminen*"), and U.S. Patent Publication Number 2004/0153676 ("*Krantz*"). Appellant respectfully traverses this rejection for at least the reason that *Sundar* in view of *Nurminen*, and *Krantz* fails to disclose, teach, or suggest all of the elements of claim 45. More specifically, dependent claim 45 is believed to be allowable for at least the reason that this claim depends from and includes the elements of allowable independent claim 42. *In re Fine, Minnesota Mining and Mfg. Co. v. Chemque, Inc.*, 303 F.3d 1294, 1299 (Fed. Cir. 2002).

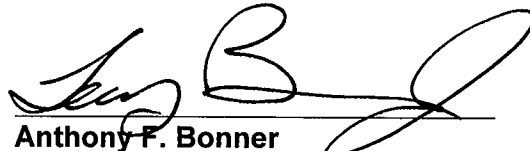
**C. Rejections Under 35 U.S.C. §112**

The Office Action indicates that claim 1 stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection is not being argued in this appeal.

### **CONCLUSION**

Applicants respectfully request that the Patent Office accept and consider the Appeal Brief submitted herewith. If the Examiner has any questions or comments regarding this paper, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,



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